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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,894	07/24/2006	Didier Courtois	112701-735	8671

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EXAMINER	
MCCORMICK, MELENIE LEE	

ART UNIT	PAPER NUMBER
1655	

NOTIFICATION DATE	DELIVERY MODE
07/21/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No.	Applicant(s)	
	10/595,894	COURTOIS ET AL.	
	Examiner	Art Unit	
	MELENIE MCCORMICK	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *1,2,4-13 and 16-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3, 14-15 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response with claim amendments submitted 04 April 2008 have been received and considered.

Claims 1-19 are pending.

Claims 1-2, 4-13, and 16-18 are withdrawn from consideration.

Claims 3, 14-15 and 19 are presented for examination on the merits.

Withdrawn Rejections

The previous rejection under 35 U.S.C. 112, second paragraph has been withdrawn in view of the claim amendment to claim 3, which now recites the term 'obtained'.

The previous rejections under 35 U.S.C. 102(b) have been withdrawn in view of the amendments to the claims which now require that a particular amount of glucosamine is present in the composition.

New Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 14-15, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite 'glucosamine is present in the product in an amount greater than about 150 mg/kg dry matter'. The specification does not define what is meant by 'greater than about' and only discussed that glucosasmine may be present in amounts 'above 150 mg per kg' (see e.g. page 9). It is therefore not clear that Applicants were in possession of a composition comprising glucosamine in an amount 'greater than about 150 mg/kg', since this amount would also encompasses amounts that are not 'above 150 mg/kg', as originally disclosed.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 14 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ecochard (US 6,916,622).

Ecochard teaches a foodstuff which comprises a chicory powder (see e.g. col 3, lines 18-24). Ecochard further teaches that the chicory is dried (formed into a powder) by heating the chicory to a temperature of 95°C, which is below 110°C, as instantly claimed. Ecochard further teaches that this heating takes place for 90 or 600 seconds (see e.g. col 4, lines 20 and 27). This dried chicory would necessarily contain glucosamine because it was produced in the same manner as instantly disclosed (i.e. drying the chicory at a temperature below 110°C for less than 1 week). Ecochard also teaches that the powder is derived from an aqueous extract of chicory (see e.g. col 1, lines 16-17).

Although Ecochard does not explicitly teach that the foodstuff comprises glucosamine in the amount instantly claimed, a person of ordinary skill in the art would reasonably expect the composition to contain essentially the same components in the same amounts as the composition instantly claimed because it was made in the same way.

With respect to the USC 102/103 rejection above, please note that the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicants' chicory composition differs and, if so, to what extent, from that of the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14 and 19 are rejected under 35 U.S.C. 102(b) as obvious over by Fleischner (US 6,420,350).

An orally ingestible composition, supplement or tablet comprising glucosamine in an amount greater than about 150 mg/kg of dry matter is claimed.

Fleishcner teaches a supplement which comprises glucosamine (see e.g. col 3, lines 17-24 and claim 1). Fleishcner further teaches that the composition may be in form of a tablet (see e.g. col 3, line 35). Fleishcner discloses that the glucosamine is useful for weight loss and that it is present in an amount effective to aid in weight loss (see e.g. claim 1). Although Fleishcner does not necessarily teach that the glucosamine was obtained or generated from a dried plant, the composition taught by Fleishcner comprises glucosamine as instantly claimed.

Fleishcner does not explicitly teach that the glucosamine is present in the amount instantly claimed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to prepare a composition comprising glucosamine. A

person of ordinary skill in the art would have had a reasonable expectation of success in adjusting the amount of glucosamine within the composition and would have been motivated to do so in order to optimize the amount which yield the most beneficial weight loss results. A person of ordinary skill in the art would have had a reasonable expectation of success because Fleishcner discloses that the amount of glucosamine present is effective to aid in weight loss. Therefore optimization based on an individual's weight and age would be within the level of ordinary skill in the art and would be expected.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being obvious over Noel (US 5,141,964).

A composition comprising glucosamine in an amount greater than about 150 mg/kg of dry matter is claimed.

Noel teaches a cosmetic composition comprising glucosamine (see e.g. claim 1). Noel further teaches that the composition may be a cream, toner, body emulsion, liquid soap and dermatological bar which is intended to be applied to the skin (see e.g. claims 6 and 7). Although Noel does not necessarily teach that the glucosamine was obtained

in the manner instantly claimed (by drying a plant), the composition taught by Noel comprises glucosamine as instantly claimed.

Noel does not explicitly teach that the amount of glucosamine in the composition is the same as that instantly claimed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to optimize the amount of glucosamine in the cosmetic composition taught by Noel because Noel teaches that glucosamine and the other components of the cosmetic composition moisturize the epidermis and are sufficient to moisturize and improve the condition of the epidermis (see e.g. col 1, lines 27-32 and lines 46-53). Therefore, a person of ordinary skill in the art would have a reasonable expectation of success in adjusting the amount of glucosamine in the composition taught by Noel in order to achieve a beneficial level of moisture in the skin of an individual. Because individual's skin will differ in the amount of moisturizing necessary, a person of ordinary skill in the art would have good reason to prepare compositions with various amounts of active moisturizing components, including glucosamine.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

With respect to the art rejections above, please note that "the patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Response to Arguments

Applicants have discussed their findings relating to the formation of glucosamine during the drying process of plants and Applicants argue that the cited references do not disclose, teach or suggest this finding. This is not persuasive, and is not commensurate in scope with the claims. Applicant's claims are directed to compositions which contain glucosamine, not methods of generating glucosamine by drying plants. Claims 14-15 and 19 do not require plant matter to be present in the composition, only that glucosamine is present. The manner in which the glucosamine was generated or obtained does not distinguish the composition from any other composition containing

glucosamine. Therefore, the claims are anticipated and obvious over the cited references as discussed in this and the previous Office Action.

Applicants also argue that the drying process of the present disclosure used fresh or raw plants. This is also not persuasive because this also relates to a method, while Applicants claims are drawn to a composition. In addition, the claim 3 does not recite 'raw' plant materials and claims do not recite 'raw' or 'fresh' plant materials. The chicory powder of Ecochard is obtained from an extract of chicory (see e.g. Ecochard col 1, lines 16-17) and therefore reads on a plant extract as claimed.

Ecochard

Applicants argue that Ecochard is directed toward the treatment of chicory powder with conditions that melt the powder so that the particles are agglomerated and is in direct contrast to the present invention, which uses fresh plants to increase to obtain an increase in levels of glucosamine. Applicants further argue that this significant difference does not allow the conclusion that both methods will produce the same plant material with high levels of glucosamine. This is not found persuasive. Claim 3 is directed to a product obtained by a proces for generating glucosaine from plants, wherein the product comprises glucosamine in an amount greater that 150 mprocessry matter and wherein the process comprises the steps of drying fresh plants *or plant extract* to a temperature below 110°C for less than one week. As discussed above, Ecochard teaches that the chicory product used as a starting material is an extract of

chicory (see e.g. col 1, lines 16-17). In addition, Ecochard's method meets the limitations of the product by process instantly claimed because the powder extract is dried by heating the chicory to a temperature of 95°C, which is below 110°C for 90 or 600 seconds, which is less than one week. As discussed previously, it would be expected that a product produced in the manner of the product by process claimed would have the same components in the same amounts claimed. In addition, claims 14 and 19 do not recite 'fresh' or 'raw' plant materials.

Fleischner and Noel

Applicants argue that Fleischner is directed entirely toward a weight loss product having supplemental compositions and that Noel is entirely directed toward a cosmetic composition comprising a cosmetic base containing a mixture of chitosan, glucosamine and at least one acid selected from the group consisting of succinic acid and gluconic acid. Applicants further argue that Fleischner and Noel fail to teach each and every limitation of the claims and that Office admits that Fleishner and Noel fail to teach the limitations of the claims. This is not found persuasive. The current rejections of record are under 35 U.S.C. 103 (a), therefore even though the invention is not identically disclosed or described as set forth in section 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Applicant's claims are directed to compositions comprising glucosamine in particular amounts. Fleishner and Noel each teach compositions comprising glucosamine and it has been discussed above why it would have been obvious to person of ordinary skill in the art to optimize the amounts of glucosamine in these compositions. In addition, Applicant's claims contain the open claim language 'comprising', therefore even if Fleishner and Noel teach other components are present in the composition, they still read on the instantly claimed composition. With regard to the argument that the Office admits that Fleishner and Noel do not disclose each and every limitation of the claim, this is also not found persuasive. Applicants have pointed to page 4 of the previous Office Action, particularly lines 14- 15 and page 5, lines 7-8. These portions of the Office Action discuss the idea that even if the manner in which the prior art composition was produced is not the same as that instantly claimed, the composition itself is still the same. Applicant's product by process has not provided any structural differences between the claimed product and the product of the prior art. As previously stated, "the patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art

product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983). Applicants have not provided evidence that the glucosamine containing products of the prior art are different from the instantly claimed glucosamine containing product.

The rejection is therefore deemed proper and is maintained.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELENIE MCCORMICK whose telephone number is (571)272-8037. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melenie McCormick
Examiner
Art Unit 1655

/Patricia Leith/
Primary Examiner, Art Unit 1655